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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,622	05/22/2001	Chandrasekar Venkatraman	10960787-6	2276

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EXAMINER	
HARRELL, ROBERT B	

ART UNIT	PAPER NUMBER
2142	4

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/862,622	Applicant(s) VENKATRAMAN ET AL.	
	Examiner Robert B. Harrell	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 May 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2-5-3
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *see attached Office Action*.

Serial Number: 09/862,622
Art Unit : 2142

1. Claims 33-81 are presented for examination.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to Embedding A Web Server Into A Device For Accessing and Controlling Device Functionality by a User Interface Functioning Over A Network.

3. All related applications must be mentioned after "TITLE" and prior to "BACKGROUND OF THE INVENTION" under the heading "RELATED APPLICATIONS" in the textual portion of the Specification along with their status (eg., the Patent Number if patented, pending, abandoned, exc...).

4. Use of active hyperlink and/or other forms of browser executable code is improper (see MPEP 608.01) and must be removed (see page 18 as one example, all others must also be removed).

5. Each of the claimed features must be shown in the figures or the features must be cancelled (ie., there is no "video player"

in the figures).

6. The following is a quotation of the first paragraph of 35 U.S.C 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The specification is objected to under 35 U.S.C 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure and/or written description for the reasons indicated infra.

8. There are a variety of specific devices specifically named in the specification and claimed which inherently have their own set of native controls and or languages. The fax machine of page 10 is not controlled in the same manner as is the video player of page 12 in that a fax machine does not have a "rewind" function nor does a video player have a "fine" setting. These two devices are just an example among the recited specific devices. There is a lack of disclosure and/or written description allowing the devices to interface with the network so they can be monitored and controlled by a remote user via an network. Where is the source code and hardware allowing one to control the video player and/or fax machine by a user on a Browser via the network? The

missing gap, or "black box", is a unit internal or external to the specific device that interfaces the specific device to the network by way of hardware and software. While a general "device" is called for in the specification, a "grocery list" recital of specific devices that can be substituted for the general device fails to provide an enabling disclosure and/or written description without that specific devices interface hardware and software to the network. For example, page 12 (line 12) states "software or firmware", but there is no showing of such in the application and/or discloser(s) as originally filed leaving one skilled in the art to create his own software and firmware (an if needed hardware) to permit proper interfacing to the network. In all, as an example, page 10 recites a grocery list of devices (line 5) without even a suggestion of how the specific device is interfaced to the network. Just stating a "refrigerator" is connected to the network void of the hardware required to control the refrigerator and software/firmware to control the hardware simply means any device under the sun can be the generic device all of which are treated as equivalent to the general device.

9. Claims 33-81 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

10. A non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy

reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by

a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

11. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

12. Claims 33-81 of this application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No 5,956,487 and/or claims 1-32 or U.S. Patent 6,170,007. Although the conflicting claims are not word for word identical, they are not patentably distinct from each other because of the reasons outline infra.

13. In light of the recital of specific devices, as substitutes for the generically disclosed device without any showing of hardware and/or software/firmware in this application, the claims of this application also recite connecting an embedded web server device generically connected to a network for monitor and control by a remote user. Thus substituting one device for another device would have been obvious to those skilled in the art because there is no disclosure of specific hardware and/or software/firmware native to that device. The only difference

between the device in this application and those of the other claims is the "name" and/or "type" of the device with no disclosure of interfacing the device with the network for monitor and control by a remote user via a network.

14. Claims 33-81 of this application are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all pending claims, as of the mailing date of this application, of anyone of copending U.S. Application Number: 09/721,409, 09/862,230, 09/862,804, 09/863,300, 09/863,368, 09/863,667, 09/865,347, 09/865,944, 09/865,977. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth infra. This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented. The applicant is reminded of timely filed terminal disclaimers as indicated above.

15. In light of the recital of specific devices, as substitutes for the generically disclosed device without any showing of hardware and/or software/firmware in this application, the claims of this application also recite connecting an embedded web server device generically connected to a network for monitor and control by a remote user. Thus substituting one device for another device would have been obvious to those skilled in the art because there is no disclosure of specific hardware and/or software/firmware native to that device. The only difference between the device in this application and those of the other claims is the "name" and/or "type" of the device with no

disclosure of interfacing the device with the network for monitor and control by a remote user via a network.

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

17. Claims 33-81 of this application are rejected under 35 U.S.C. 102 (e) as being anticipated by Martenson (U.S. 6,219,708 B1).

18. Per claim 35, Martenson taught a mechanism of a fax machine (eg., see col. 3 (lines 24-26 "any device")), comprising an embedded web server (eg., see col. 8 (line 41-et seq.)), and a network interface (eg., see figure 2 and figure 3 (380)).

19. Per claims 34 and 35 see col. 2 (lines 6-9), and col. 8 (line 15).

20. Per claim 36, all of the figure's figure 4 was the claimed

monitor.

21. Per claim 37, see col. 8 (lines 26-40), and other such related HTML documents in the reference.

22. Per claims 38-81, these claims are identical in wording of claim 33 with only the device name or type being changed (eg., a magnetic tape over the optical storage medium, or television or thermostat, or refrigerator, exc... over that of the video player). Thus these other specific devices also fall under the category of "any device" per col. 3 (line 24).

23. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

25. Claims 33-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martenson (US 6,219,708 B1) in view of Joao (5,917,405).

26. While Martenson did not specifically name his device or the

type of device, just a general generic device per col. 3 (line 24), he did mention in col. 17 (lines 8-10) the device could be any device under the sun which could be interfaced to a network. A recital of such devices which could be interfaced to a network was provided by Joao in col. 12 (line 8 (VCR), line 7 (television), col. 13 (line 26 "thermostat"), col. 24 (line 24 "refrigerator"), and more... (eg., see col. 12 (lines 9-13).

27. It would have been obvious to one skilled in the data processing art to have combined the teachings of these two references because they both were directed toward the problem of controlling a device via a network by a user with a Web browser (eg., see figure 5B(520 and 520). But specifically, since Martenson was silent on the type of device, one skilled in the art would have obviously sought elsewhere for a specific type of device that could be controlled over the Internet such as a toaster (eg., see col. 12 (line 10)). It is noted that while Joao's Web Server was not embedded in the device as with Martenson, Joao is only provided to show the type of devices that could be controlled via the Internet using a Web Server and Web Browser.

28. For all the reasons cited above, placing a Web Server into any controllable device (ie., toaster) such that device could be

controlled by a remote user having a Web Browser over the Internet was either anticipated or obvious.

29. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

32. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142